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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,773	10/17/2000	Geoffrey B. Rhoads	60310	3646

23735 7590 02/09/2004

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER
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HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 02/09/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/690,773

Applicant(s)

RHOADS ET AL.

Examiner

Tadesse Hailu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6, 7, 10-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) 5, 8, 9, 14 and 18-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

1. This Office Action is in response to the Amendment entered 11/17/2003 for the patent application (09/690,773) filed 10/17/2000.
2. The amended patent application claims priority from US Application 08/508,083, filed July 27, 1995 (now US Pat No. 5,841,978).
3. The pending claims 1-23 are examined as follows:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 6, 10, 11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Gudmundson et al (5,680,619).

With regard to claim 1:

Gudmundson is directed to application development systems generally, and in particular to systems for authoring interactive multimedia applications (column 3, lines 5-7).

Gudmundson describes a system that models "container" relationship among objects in a manner that permits authors to selectively reuse object containers and the objects they contain across different container environments (column 8, lines 17-20).

Similar to claim 1, Gudmundson discloses a system that provides for significant reusability of object containers by utilizing the Structural and Behavioral Hierarchies to isolate the external dependencies of Elements and Behaviors (column 9, lines 45-55). Gudmundson also discloses a registration system enabling the user to specify and modify the object containers (elements and Behaviors i.e., Modifier containers) (column 61, lines 38-column 62, lines 26). Gudmundson further describes a symbol manager 19 associates names of objects with internal reference Ids (column 52, lines 1-4). Gudmundson also discloses a database management system that provides centralized access to all external resources (column 46, lines 9-26).

With regard to claim 2:

Gudmundson also discloses a network interface that enables objects to communicate by directly calling one another's capabilities or "methods." (column 46, lines 48-column 47, lines 14).

With regard to claim 6:

The system of Gudmundson also includes a user interface (Figs. 2-4) that enables a user to view an image of an object along with an image of a behavior to be associated with the

object, the user interface including a control that enables the user to associate the object with the behavior, and the user interface being operable to communicate a database structure to the database management system specifying an object identifier for the object and a description of the behavior. The system of Gudmundson further includes application programmer's interface (Component API 21) that enables the core 99 of the system to communicate with the various Components (Modifiers and Services) created by programmers. The Component manager 20 permits programmers to add custom Modifiers and Services to the system (column 52, lines 10-18).

With regard to claim 10:

Independent claim 10 is a method claim corresponding to system claim 1, and is believed to be unpatentable for at least the same reasons as described above in connection with claim 1. In addition as per the step of updating a database is also described (see Gudmundson, column 25, lines 24-30).

With regard to claim 11:

Gudmundson describes specification of the object includes id or identifier provided on the on the object (column 52, lines 1-4).

With regard to claim 15:

Claim 15 is a computer readable medium claim corresponding to method claim 10, and is believed to be unpatentable for at least the same reasons as described above in connection with claim 10.

5. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Conley (US 5,689,626).

With regard to claim 16:

Conley describes a watermark enabled document (object) associated with a printer (machine) prints (behavior) the proper watermark document by first scanning the watermark file “stick” (embedded) into the document (column 6, lines 1-6), wherein printing is taking place or triggers when a printer driver searches and matches (reads) at least one of the watermark identifiers (column 4, lines 17-26).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 7, 12, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudmundson et al (5,680,619) in view of Conley (US 5,689,626).

With regard to claim 3:

Gudmundson’s application development system describes enabling its users to create selectively reusable object containers merely by defining links among objects (abstract). While the system also describes associating names of objects with internal reference Ids (column 52, lines 1-4), but the system fails to describe the internal reference Ids (object identifiers) comprises watermark identifiers, which are embedded in watermark on corresponding objects. Conley describes an application program that support watermarking, that is, a program that link a selected watermark to a document (abstract). Furthermore, Conley describes watermark file “stick” (embedded) into the document. The system also describes identifiers (first and second)

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associated with the watermark file (column 3, lines 28-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate or embed the watermark described in Conley with Gudmundson's element object. Thus, one of the principal advantages of the embedded watermark is to detect a counterfeited security document.

With claims 4 and 17:

Since Gudmundson in view of Conley describes watermark file "stick" to a document and Conley further describes the use of watermark file whenever the document is printed in paper, thus, this watermarked printed paper can be said a watermarked sticker (Conley, column 3, lines 56-64).

With regard to Claims 7 and 12:

Gudmundson in view of Conley describes the file object identifier is "stick" (embedded) into the document object using a watermark (Conley, column 3, lines 28-40).

With regard to claim 13:

Gudmundson in view of Conley describes a dialog box is launched in response to matching or reading the watermark on the document or file (Conley, column 4, lines 27-35).

***Allowable Subject Matter***

7. Claims 5, 8, 9, 14, and 18-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records fails to disclose the system in which the machine behavior includes fetching a web site relating to an object carrying the object identifier (claim 5), similarly, the prior art of records fails to disclose a system in which the behavior is fetching a web page (claims 8-9). The prior art of records also fails to disclose a method wherein the user interface is a web-based interface, and the user establishes a connection with the web-based interface automatically in response to decoding the watermark on the object (claim 14). The prior art of records fails to disclose an object in which the object is a prop in a computer game, and the prop supplies information to the computer game by conveying the information in a message embedded in a watermark on the prop (claims 18, 20). The prior art of records fails to disclose an object in which the object has two or more facets, each facet being embedded with a different watermark message used to control the game (claim 19). ). The prior art of records further fails to describe the machine behavior to include launching an e-mail program that is directed to a destination associated with the object via the watermark (claim 21), the machine behavior to include launching an Internet chat session, and the machine behavior to include placing a telephone call to a destination associated with the object (claim 23).

Thus, prior art neither renders obvious nor anticipates the combination of claimed elements in light of the specification



***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

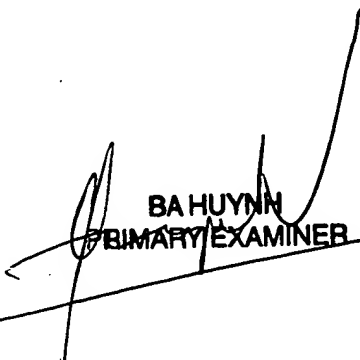
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 8:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

*Tadesse Hailu*

Feb 5, 2004

  
**BA HUYNH**  
**PRIMARY EXAMINER**